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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,497	07/05/2001	Hirohisa A. Tanaka	05274.00016	8442

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FENWICK & WEST LLP  
SILICON VALLEY CENTER  
801 CALIFORNIA STREET  
MOUNTAIN VIEW, CA 94041

EXAMINER
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MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,497

Applicant(s)

TANAKA ET AL

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/03 has been entered.

### ***Amendment***

2. Applicant's submittal of an amendment was entered on 9/29/03, wherein:  
claims 1-33 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2002/0077130 A1 (Owensby).

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In regards to independent **claim 1**, Owensby discloses a method for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising the steps of:

determining whether a location of the MU is inside or outside a predetermined subsidized zone (see paragraph 60);

responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate (see page 11, paragraph 72); and

responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate (it is inherent that a non-subsidized rate will apply when the user is not in a subsidized zone, see page 12, paragraph 79);

**[claim 2]** the first predetermined billing rate is less than the second predetermined billing rate (it is inherent that the subsidized rate will be less than the non-subsidized rate);

**[claim 4]** the location is determined by a Global Positioning System (GPS) (see page 7, paragraph 45);

**[claim 6]** information corresponding to the predetermined subsidized zone is stored in a database (see page 8, paragraph 52);

**[claim 7]** the predetermined subsidized zone information comprises a time period (see page 10, paragraph 64; wherein the Ad Selection is determined by among other things, “date and time”), and wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period;

**[claim 8]** the predetermined subsidized zone is defined by a geographical point and a radius (it is inherent that cellular phone systems include zones that are defined by a radius, see page 7, paragraph 45) ;

**[claim 9]** the predetermined subsidized zone is associated with a proximity to a commercial establishment (see for example, page 3, paragraph 15, “restaurant in the area”) and the commercial establishment pays the first predetermined billing rate (it is inherent that the commercial establishment pays the subsidy);

**[claim 10]** the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment (it is inherent that the system is used over in a plurality of locations with a plurality of commercial establishments, see page 10, paragraph 60); and

**[claim 11]** the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone (see page 11, paragraph 72, wherein it is noted that the subsidy is flexible and changes dependent on numerous factors).

In regards to independent **claim 12**, Owensby discloses a system for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising: a processor (operator billing system 32, see page 10, paragraph 60); memory for storing computer readable instructions that, when executed by the process, cause the system to perform billing operations. In regards to independent **claim 23**, Owensby discloses a computer program product for determining a billing rate of a mobile telecommunications

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connection associated with a mobile telecommunications unit (MU) comprising a computer-readable medium containing computer program code for performing billing operations. In order to omit redundant explanations of claimed limitations, it is noted that Owensby discloses all the elements cited in claims 12-33 as outlined in detail for similar claims 1-11.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5, 14, 16, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby in view of U.S. Patent No. 6,411,891 (Jones).

Owensby discloses all of the limitations as set forth above but fails to explicitly state alternative methods of determining the geographic location of the mobile unit.

Jones specifically teaches the use of detecting the geographic location of a mobile telecommunications unit by **[claim 3]** longitude and latitude (see column 17, lines 8-10) and **[claim 5]** Universal Transverse Mercator (UTM) numbers (see column 17, lines 8-10).

Since **claims 14 & 16 and 25 & 27** are identical to claims 3 & 5, a detailed description of each limitation will not be repeated.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Owensby with the location detection mechanism of longitude/latitude or UTM as taught by Jones, because the use of an accurate geographic location mechanism as

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taught will improve the efficiency and the successfulness of the advertisements, wherein the system will be able to better pinpoint the proximity of the mobile unit to a commercial establishment.

***Response to Arguments***

7. Applicant's arguments filed September 29, 2003 have been fully considered but they are not persuasive.

On page 7, third paragraph, Applicant argues that claims 12-33 are not hybrid claims because MPEP 2106 IV (b)(2) allows a claim to identify a physical structure of a machine or manufacture in terms of its hardware or hardware and software combination. In view of MPEP 2106 IV (b)(2), the 35 U.S.C. § 101 and 35 U.S.C. § 112 rejections are withdrawn.

On page 8, second paragraph, Applicant argues that Owensby requires a user to accept an advertisement in order to get a discount, the claimed invention changes the billing rate for the user subject "only" to the location of the MU. It appears that Applicant is arguing limitation not found in the claim. Claim 1 does not require that changes to the user's billing rate is "only" due to the location of the user. Claim 1 merely requires determining the location of the MU as either inside or outside a predetermined subsidized zone. Owensby requires a system to determine if the MU is inside or outside a subsidized zone. While Owensby requires the user to accept an advertisement, the claim does not preclude that additional step.

*Conclusion*

8. This is a continuation of applicant's earlier Application No. 09/898,497. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

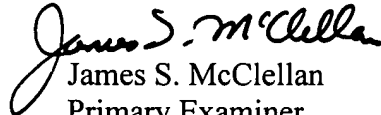
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
February 26, 2004